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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,639	09/19/2001	Andrew L. Niles	34506.115	1780

7590 04/28/2003

Intellectual Property Department  
DEWITT ROSS & STEVENS S.C.  
Firststar Financial Centre  
8000 Excelsior Drive, Suite 401  
Madison, WI 53717-1914

EXAMINER

CELSA, BENNETT M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 04/28/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

file copy

**Office Action Summary**

Application No.

09/955,639

Applicant(s)

Niles et al.

Examiner

Bennett Celsa

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-48 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_                      6) ☐ Other:

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### **DETAILED ACTION**

Claims 1-48 are currently pending.

NOTE: the location of the present application is ART UNIT 1639.

#### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, drawn to N-terminally protected and unprotected peptides, classified in class 530, subclass 300.
  - II. Claims 4-15, 41, 42, 44-47 and 28-37, drawn to labeled peptides, kits and screening assay (e.g. competitive inhibition) , classified in class 436, subclass 800.
  - III. Claims 16-27, 43, 48 and 38-40, drawn to peptide ketones, kits and screening method (e.g. irreversible inhibition), classified in class 436, subclass 503.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are drawn to different peptides, compositions and use thereof, in which the peptides of the different groups are patentably distinct due to differences in chemical structure, properties and are capable of separate manufacture and/or use and which require different and separately burdensome manual/computer sequence, structure and bibliographic searches.
3. Inventions I and (II or III) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP

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§ 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product e.g. such as the pharmaceutical use (e.g. antiallergens) of the Group I peptides. Additionally, the process for using the product as claimed can be practiced with another materially different product e.g. the use of peptide ketones instead of protected/unprotected peptides of Group I in assays (E.g irreversible inhibition).

4. Because these inventions are distinct for the reasons given above and
  - a. have acquired a separate status in the art as shown by their different classification;
  - b. required different and separately burdensome manual/computer structure/sequence/bibliographic searches in patent/literature databases.
  - c. because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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***ELECTION OF SPECIES (FOR GROUPS I-III ABOVE)***

5. This application contains claims directed to the following patentably distinct species of the claimed invention: peptides which comprise different amino acid sequences which require different and separately burdensome manual/computer sequence and bibliographic searches. Eg. See sequence Id. 1-23.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (e.g. a single peptide compound) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

**General information regarding further correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Celsa whose telephone number is (703) 305-7556.

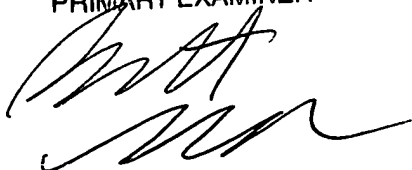
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang (art unit 1639), can be reached at (703)306-3217.

Any inquiry of a general nature, or relating to the status of this application, should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Bennett Celsa (art unit 1639)

April 22, 2003

**BENNETT CELSA  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to be 'Bennett Celsa', written over the printed name and title.